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10/723,018	11/26/2003	Hugh Harnsberger	12382.0015.P	1781

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EXAMINER

FILIPCZYK, MARCIN R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,018	Applicant(s) HARNSBERGER ET AL.	
	Examiner Marc R. Filipczyk	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/4/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This Action is responsive to Applicant's RCE and amendment filed on April 4, 2008, wherein claims 1-15 are pending.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/4/08 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the claim falls within one of the four statutory categories of invention recited in 35 U.S.C. § 101: process, machine, manufacture and composition of matter: The latter three define "things" or "products", while a "process" consists

of a series of steps or acts to be performed. A process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform an article or physical object to a different state or thing. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

In the present case, independent claim 6 is a process claim. Claim 6 does not involve transformation of article or physical object to a different state or thing. Further, independent claim 1 does not tie into another statutory class such as a particular apparatus (i.e., computer comprising a physical processor).

Therefore, claim 6, claims 7-10 which depend from claim 6, respectively, taken as a whole are directed to a mere method, i.e., to only its description, or an abstract idea, hence are non-statutory.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In the present case, claim 11 only recites a system but does not include any hardware to claim a physical system but instead is geared towards a program, and is rejected as program per se. A computer program is statutory while being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the

instructions set forth in the computer program.

Claim 11 does not execute any action.

Hence, claim 11 taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is descriptive material per se and hence is nonstatutory.

Since the claimed invention taken as a whole is not within the technological arts as explained above, claims 12-15 depend from claim 11 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefanescu et al (U.S. Publication No. 2003/0013951).

Regarding claims 1, 6 and 9, Stefanescu discloses a method and system for creating a medical reference book on a desired topic, comprising the steps of: (abstract)

entering medical reference information in an electronic authoring tool (figures 4-7), the electronic authoring tool including: (fig. 4, page 5, par. 50, lines 1-16)

a master outline authoring tool (figures 4-7), whereby an author is able to create a linkage between a diagnosis, an anatomical region, and a pathology; (par. 53, lines 1-6 and par. 56, lines 5-8)

a case authoring tool (figures 4-7), whereby the author is able to enter and edit images and text relating to a particular case; (par. 52, lines 6-12, par. 53, lines 1-6, par. 54, lines 13-23 and par. 56).

a diagnostic authoring tool (figures 4-7), whereby the author is able to create a comprehensive description of the diagnosis; (par. 55, lines 3-5)
transferring the medical reference information into a content database; (figs. 8 and 10, page 9, par. 83 and 84)

*(Note 1: limitations **above** teach building and using a medical database system)*

*(Note 2: limitations **below** teach searching and retrieving the desired material from the medical database system)*

selecting a desired topic about which the electronic clinical reference material is to be created; (pages 9, par. 89)

navigating the content database for medical reference information pertaining to the desired topic; (page 10, par. 92 and 93) and

generating the medical reference book on a desired topic (page 10, par. 92 and 93).

Regarding claim 2, Stefanescu discloses reviewing the medical reference information prior to transferring it to the content database (fig. 8, item 824 and par. 92).

Regarding claims 3 and 4, Stefanescu discloses reference book is a printed and or electronic book (par. 93).

(Note: all electronic documents may be in printed)

Regarding claim 5, Stefanescu discloses a GUI (figs. 4-7 and par. 70).

Regarding claim 7, Stefanescu discloses providing imaging protocols (page 11, par. 99).

Regarding claim 8, Stefanescu discloses a continuing education system comprising performance and credits (figs 4 and 16, item 1634, also see *internet*).

Regarding claim 10, Stefanescu discloses database is searchable online (fig. 1 and col. 25).

Regarding claims 11-15, they disclose limitations already addressed and rejected in the rejection above, in addition see fig. 2, items 200-206 of Stefanescu.

Response to Arguments

Applicant's arguments filed on 4/4/08 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on pages 2 and 3 that indefinite and enablement rejections have been overcome by the previous amendments.

In view of Applicant arguments Examiner withdraws previous indefinite and enablement rejections. Examiner notes that “medical reference information” is interpreted to mean helpful materials/content and “medical reference book” to mean either print or electronic publications.

Applicant argues on page 6 that the prior art does not teach compilation of either electronic or print book.

Examiner disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., compiling) are not recited in the rejected claim(s).

In addition, in paragraph 93, Stefanescu clearly teaches pre-processing of findings for review and dispatch. Preprocessing requires compilation of data.

Applicant argues on page 7 that the prior art does not teach linking data

Examiner disagrees. The claimed tools include an interface creating links between a diagnosis, anatomical region and pathology, entering data, diagnosing the data, all of which is taught by Stefanescu in paragraphs 53, 55 and 56. Note, Stefanescu's matching linkage is achieved by a matching button for matching reference text to images and clinical data used by the system, see paragraph 56.

Applicant argues on pages 7 and 8 the prior art does not teach selecting a desired topic or transferring information into a content database.

The features argued are explicitly disclosed by the prior art, specifically in paragraphs 83, 84, 92 and 93. For detailed information please refer to the rejections and remarks above.

With respect to all the pending claims 1-15, Examiner respectfully traverses Applicants assertions based on the discussion and rejection cited above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents demonstrate the state of art with respect to medical systems.

U.S. Patent No. 6,263,330 of Bessette

U.S. Patent No. 6,757,898 of Ilсен et al.

U.S. Patent No. 6,850,944 of MacCall et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019.

The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2163

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

June 9, 2008

/Marc R Filipczyk/

Examiner, Art Unit 2163

./don wong/

Supervisory Patent Examiner, Art Unit 2163